IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	*McGee et al.*	Confirmation No.:	7972
Serial No.:	10/810,325	Art Unit:	1625
Filed:	March 25, 2004	Examiner:	D. Margaret M. Seaman
For:	COMPOUNDS FOR THE MODULATION OF PPARγ ACTIVITY	Attorney Docket No.:	T-99-008-3/US (11134-123-999)

PETITION TO REVIVE
UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 C.F.R. § 1.137(b)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notice of Abandonment of the above-identified application mailed June 25, 2007, Applicants respectfully petition the United States Patent and Trademark Office ("USPTO") to revive the instant application under 37 C.F.R. § 1.137(b) on the ground that the application was unintentionally abandoned. A copy of the Notice of Abandonment is attached with this petition as Exhibit A.

Applicants hereby state that the entire delay to the date this petition is filed was unintentional.

Applicants believe that the above-identified application became abandoned as a result of an error on the part of the Patent Office. A response to the final Office Action dated December 18, 2006, was due in connection with the above-identified patent application June 18, 2007. On June 15, 2007, Applicants filed the response, with an associated Petition for Extension of Time and Notice of Appeal by Express Mail. A copy of the Response and associated documents is attached as Exhibit B The response as filed indicated Applicant's intention to file a Petition for an Extension of Time and a Notice of Appeal on page 1 of the response, and authorized the payment of any required fee on page 26 of the response.

A copy of the postcard attached with this filing and Express Mail Recipt evidencing the filing of the Response with associated documents on June 15, 2007, is attached hereto as Exhibit C. Applicants note that the postcard contains an unfortunate typographical error in the Application Serial Number and thus inadvertently misidentifies the documents.

Applicants further note that similar unfortunate typographical errors occur in the Petition for Extension of Time and the Notice of Appeal originally filed. The Petition and Notice correctly identified the first named Inventor, Title, Filing Date, Confirmation Number, Art Unit, Examiner, and Attorney Docket Number for the instant application.

Nonetheless, Applicants hereby represent that the response was timely filed, together with an indication of Applicants' Notice of Appeal and Petition for Extension of Time, with the authorization to pay the required fees, and that this response correctly identified the present application. Taken together, Applicants believe that the evidence presented in Exhibits B and C indicate that the present application was abandoned because of an error on the part of the patent office, *i.e.*, mishandling the Response to Final Office Action filed June 15, 2007.

Applicants submit herewith a copy of the Response originally filed June 15, 2007, together with a corrected Petition for Extension of Time and Notice of Appeal.

Accordingly, Applicants hereby respectfully request that the application be revived, and that the Response and Notice of Appeal submitted herewith be accepted and made of record into the file of the present application.

CONCLUSION

Applicants hereby respectfully request that the Patent Office revive the above-identified patent application. Further, Applicants respectfully request revival without charging the Petition Fee as the present application became abandoned as a result of an error on the part of the Patent Office. However, should the Patent Office determine that the Petition fee is appropriate, please charge the required fee of $1540.00 to Jones Day's Deposit Account No. 50-3013 (Referencing No. 893053-999123).

Respectfully submitted,

Date: **October 16, 2007**

56,056
David C. Pauling (Reg. No.)
For: Anthony M. Insogna (Reg. No. 35,203)
JONES DAY
222 East 41st Street
New York, New York 10017
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EXHIBIT A

T99-008-US-CNT2
CIS

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,325	03/25/2004	Lawrence R. McGee	T99-008-3/US	7972

30174 7590 06/25/2007
AMGEN INC.
1120 VETERANS BOULEVARD
SOUTH SAN FRANCISCO, CA 94080

EXAMINER	
SEAMAN, D MARGARET M	
ART UNIT	PAPER NUMBER
1625	
MAIL DATE	DELIVERY MODE
06/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Restrictive

11134-12

Notice of Abandonment	Application No.	Applicant(s)	
	10/810,325	MCGEE ET AL.	
	Examiner	Art Unit	
	/D. Margaret Seaman/	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on *18 December 2006*.
   (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
   (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
   (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
   (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
   (d) ☒ No reply has been received.

2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
   (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
   (b) ☐ The submitted fee of $_____ is insufficient. A balance of $_____ is due.
   The issue fee required by 37 CFR 1.18 is $_____. The publication fee, if required by 37 CFR 1.18(d), is $_____.
   (c) ☐ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
   (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
   (b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☐ The reason(s) below:

/D. Margaret Seaman/
Primary Examiner
Art Unit: 1625

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Interview Summary	Application No.	Applicant(s)
	10/810,325	MCGEE ET .
	Examiner	Art Unit
	/D. Margaret Seaman/	1625

All participants (applicant, applicant's representative, PTO personnel):

(1) */D. Margaret Seaman/*. (3)_____.

(2) *Christopher Smith*. (4)_____.

Date of Interview: *20 June 2007*.

Type: a)☒ Telephonic b)☐ Video Conference
c)☐ Personal [copy given to: 1)☐ applicant 2)☐ applicant's representative]

Exhibit shown or demonstration conducted: d)☐ Yes e)☐ No.
If Yes, brief description: _____.

Claim(s) discussed: _____.

Identification of prior art discussed: _____.

Agreement with respect to the claims f)☐ was reached. g)☐ was not reached. h)☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: *A call was made to determine of there was a response made to the office aciton mailed 12/18/2006. No response has been received.*.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

_____
Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record
A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews
Paragraph (b)
In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.
All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:
- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:
1) A brief description of the nature of any exhibit shown or any demonstration conducted,
2) an identification of the claims discussed,
3) an identification of the specific prior art discussed,
4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
6) a general indication of any other pertinent matters discussed, and
7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

EXHIBIT B

Express Mail No: EV 922 265 446 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	McGee et al.	Confirmation No.:	7972
Serial No.:	10/810,325	Art Unit:	1625
Filed:	March 25, 2004	Examiner:	Seaman, D. Margaret M.
For:	Compounds for the Modulation of PPARγ Activity	Attorney Docket No.:	T99-008-3/US (11134-123-999)

AMENDMENT AND RESPONSE UNDER 37 C.F.R. § 1.116

M/S: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants have carefully considered the Final Office Action dated December 18, 2006, in connection with the above-identified patent application. In response, Applicants respectfully request reconsideration of the present application in view of the remarks that follow.

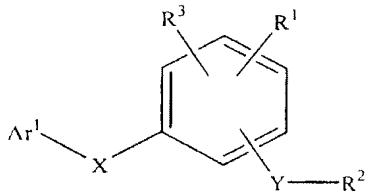
In this paper, an amendment to the claims is presented beginning on page **2**, while the remarks begin on page **16**.

Applicants file herewith a Petition for Extension of Time under 37 CFR § 1.136, with provision for the required fee, extending the time for response for a period of three (3) months from March 18, 2007, to June 18, 2007; and a Notice of Appeal; with provision for the required fee.

AMENDMENTS TO THE CLAIMS

Please amend the claims to read as follows:

Claim 1 (currently amended): A compound having the formula:



wherein

Ar^1 is a substituted or unsubstituted phenyl or a substituted or unsubstituted naphthyl;

X is a divalent linkage selected from the group consisting of ~~$(C_1$-$C_6)$alkylene, $(C_1$-$C_6)$alkylenoxy, $(C_1$-$C_6)$alkylenamino, $(C_1$-$C_6)$alkylene-$S(O)_k$-~~, -O-, -C(O)-, ~~-$N(R^{11})$-, -$N(R^{11})C(O)$-~~, -$S(O)_k$- and $\underline{-CH_2-}$ ~~a single bond~~,

wherein

~~R^{11} is a member selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl, $(C_2$-$C_8)$heteroalkyl and aryl$(C_1$-$C_4)$alkyl; and~~ the subscript k is an integer of from 0 to 2;

Y is $N(R^{12})$-$S(O)_m$-,

wherein

R^{12} is ~~independently~~ selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl, $(C_2$-$C_8)$heteroalkyl and aryl$(C_1$-$C_4)$alkyl; and the subscripts m and n are independently integers of from 0 to 2;

R^1 is a member selected from the group consisting of hydrogen, $(C_2$-$C_8)$heteroalkyl, aryl, aryl$(C_1$-$C_4)$alkyl. halogen, cyano, nitro, $(C_1$-$C_8)$alkyl, $(C_1$-$C_8)$alkoxy, -$C(O)R^{14}$, -CO_2R^{14}, -$C(O)NR^{15}R^{16}$, -$S(O)_p$-R^{14}, -$S(O)_q$-$NR^{15}R^{16}$, -O-C(O)-OR^{17}, -O-C(O)-R^{17}, -O-C(O)-$NR^{15}R^{16}$, -$N(R^{14})$-C(O)-$NR^{15}R^{16}$, -$N(R^{14})$-C(O)-R^{17} and –$N(R^{14})$-C(O)-OR^{17}.

wherein

R^{14} is a member selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl, $(C_2$-$C_8)$heteroalkyl, aryl and aryl$(C_1$-$C_4)$alkyl;

R^{15} and R^{16} are members independently selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl, $(C_2$-$C_8)$heteroalkyl, aryl, and aryl$(C_1$-$C_4)$alkyl, or taken together with the nitrogen to which each is attached form a 5-, 6- or 7-membered ring;

R^{17} is a member selected from the group consisting of $(C_1$-$C_8)$alkyl, $(C_2$-$C_8)$heteroalkyl, aryl and aryl$(C_1$-$C_4)$alkyl;

the subscript p is an integer of from 0 to 3; and

the subscript q is an integer of from 1 to 2; and

R^2 is a substituted or unsubstituted aryl; and

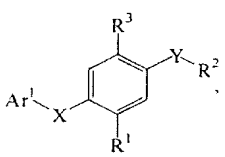
R^3 is a member selected from the group consisting of halogen, cyano, nitro and $(C_1\text{-}C_8)$alkoxy;

or a pharmaceutically acceptable salt of the compound.

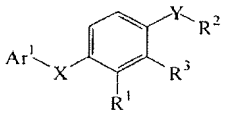
Claim 2 (previously presented): A compound of claim 1, wherein R^2 is a substituted or unsubstituted aryl selected from the group consisting of phenyl, pyridyl, naphthyl and pyridazinyl.

Claim 3 (original): A compound of claim 2, wherein Ar^1 is a substituted or unsubstituted phenyl group.

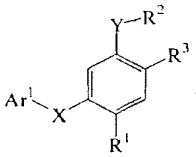
Claim 4 (original): A compound of claim 3, represented by a formula selected from the group consisting of



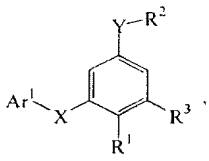
(Ia)



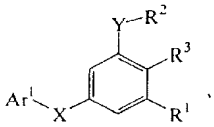
(Ib)



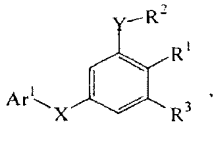
(Ic)



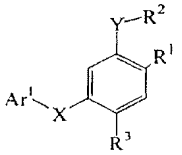
(Id)



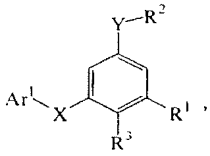
(Ie)



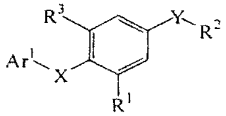
(If)



(Ig)

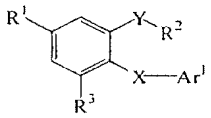


(Ih)



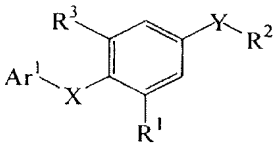
(Ii)

and

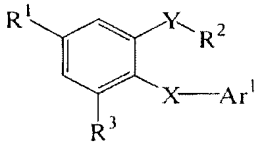


(Ij)

Claim 5 (original): A compound of claim 3, represented by a formula selected from the group consisting of



and



(Ii) (Ij)

Claim 6 (currently amended): A compound of claim 5, wherein

X is a divalent linkage selected from the group consisting of $-CH_2-$, ~~$-CH(CH_3)-$~~, -O-, -C(O)-, ~~$-N(R^{11})-$~~ and –S-;

~~wherein~~

~~R^{11} is a member selected from the group consisting of hydrogen and (C_1-C_8)alkyl;~~

Y is $-N(R^{12})-S(O)_2-$,

wherein

R^{12} is a member selected from the group consisting of hydrogen and (C_1-C_8)alkyl;

R^1 is a member selected from the group consisting of hydrogen, halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl, (C_1-C_8)alkoxy, $-C(O)R^{14}$, $-CO_2R^{14}$, $-C(O)NR^{15}R^{16}$, $-S(O)_p-R^{14}$, $-S(O)_q-NR^{15}R^{16}$, -O-C(O)-R^{17}, and $-N(R^{14})-C(O)-R^{17}$;

wherein

R^{14} is a member selected from the group consisting of hydrogen, (C_1-C_8)alkyl, hetero(C_1-C_8)alkyl, aryl and aryl(C_1-C_4)alkyl;

R^{15} and R^{16} are members independently selected from the group consisting of hydrogen, (C_1-C_8)alkyl and (C_2-C_8)heteroalkyl, or taken together with the nitrogen to which each is attached form a 5-, 6- or 7-membered ring;

R^{17} is a member selected from the group consisting of hydrogen, (C_1-C_8)alkyl and (C_2-C_8)heteroalkyl;

the subscript p is an integer of from 0 to 2; and

the subscript q is 2; and

R^2 is a substituted or unsubstituted phenyl; and

R^3 is a member selected from the group consisting of halogen and (C_1-C_8)alkoxy.

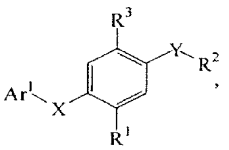
Claim 7 (currently amended): A compound of claim 6, wherein X is –O-, ~~-NH-~~ or –S-; Y is -NH-SO_2-; R^1 is a member selected from the group consisting of halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl, (C_1-C_8)alkoxy, -C(O)R^{14}, -CO_2R^{14}, -C(O)$NR^{15}R^{16}$, -$S(O)_p$-R^{14} and -$S(O)_q$-$NR^{15}R^{16}$; R^2 is a phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_8)alkyl, -C(O)-(C_1-C_8)alkyl, -CN, -CF_3, (C_1-C_8)alkyl and -NH_2; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

Claim 8 (previously presented): A compound of claim 7, wherein Ar^1 is a phenyl group having from 1 to 3 substituents selected from the group consisting of halogen, $-OCF_3$, -OH, $-O(C_1-C_6)$alkyl, $-CF_3$, (C_1-C_8)alkyl and $-NO_2$; R^1 is a member selected from the group consisting of halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl and (C_1-C_8)alkoxy; R^2 is a phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, $-OCF_3$, -OH, $-O(C_1-C_8)$alkyl, $-C(O)-(C_1-C_8)$alkyl, -CN, $-CF_3$, (C_1-C_8)alkyl and $-NH_2$; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

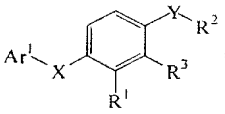
Claims 9 - 14 (canceled).

Claim 15 (original): A compound of claim 2, wherein Ar^1 is a substituted or unsubstituted naphthyl group.

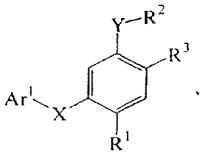
Claim 16 (original): A compound of claim 15, represented by a formula selected from the group consisting of



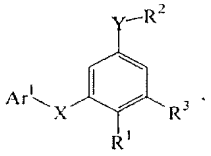
(Ia)



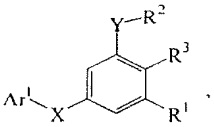
(Ib)



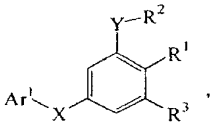
(Ic)



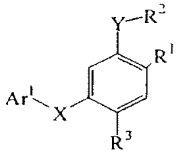
(Id)



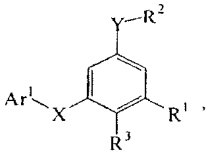
(Ie)



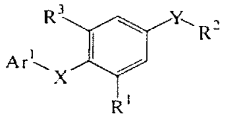
(If)



(Ig)

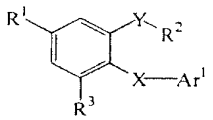


(Ih)



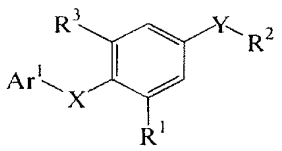
(Ii)

and



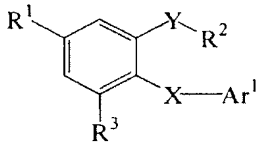
(Ij)

Claim 17 (original): A compound of claim 16, represented by a formula selected from the group consisting of



(Ii)

and



(Ij)

Claim 18 (currently amended): A compound of claim 17, wherein

X is a divalent linkage selected from the group consisting of $-CH_2-$, ~~$-CH(CH_3)-$~~, -O-, -C(O)-, ~~$-N(R^{11})-$~~ and -S-;

wherein

R^{11} is a member selected from the group consisting of hydrogen and $(C_1$-$C_8)$alkyl;

Y is $-N(R^{12})-S(O)_2-$,

wherein

R^{12} is a member selected from the group consisting of hydrogen and $(C_1$-$C_8)$alkyl;

R^1 is a member selected from the group consisting of hydrogen, halogen, $(C_1$-$C_8)$alkyl, $(C_2$-$C_8)$heteroalkyl, $(C_1$-$C_8)$alkoxy, $-C(O)R^{14}$, $-CO_2R^{14}$, $-C(O)NR^{15}R^{16}$, $-S(O)_p-R^{14}$, $-S(O)_q-NR^{15}R^{16}$, -O-C(O)-R^{17}, and $-N(R^{14})-C(O)-R^{17}$;

wherein

R^{14} is a member selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl, hetero$(C_1$-$C_8)$alkyl, aryl and aryl$(C_1$-$C_4)$alkyl;

R^{15} and R^{16} are members independently selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl and $(C_2$-$C_8)$heteroalkyl, or taken together with the nitrogen to which each is attached form a 5-, 6- or 7-membered ring;

R^{17} is a member selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl and $(C_2$-$C_8)$heteroalkyl;

the subscript p is an integer of from 0 to 2; and

the subscript q is 2; and

R^2 is a substituted or unsubstituted phenyl; and

R^3 is a member selected from the group consisting of halogen and $(C_1$-$C_8)$alkoxy.

Claim 19 (currently amended): A compound of claim 18, wherein X is –O-, ~~–NH–~~or –S-; Y is -NH-SO_2-; R^1 is a member selected from the group consisting of halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl, (C_1-C_8)alkoxy, -C(O)R^{14}, -CO_2R^{14}, -C(O)$NR^{15}R^{16}$, -$S(O)_p$-R^{14} and -$S(O)_q$-$NR^{15}R^{16}$; R^2 is a phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_8)alkyl, -C(O)-(C_1-C_8)alkyl, -CN, -CF_3, (C_1-C_8)alkyl and -NH_2; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

Claim 20 (original): A compound of claim 19, wherein Ar^1 is a naphthyl group having from 1 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_6)alkyl, -CF_3, (C_1-C_8)alkyl and -NO_2; R^1 is a member selected from the group consisting of halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl and (C_1-C_8)alkoxy; R^2 is a phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_8)alkyl, -C(O)-(C_1-C_8)alkyl, -CN, -CF_3, (C_1-C_8)alkyl and -NH_2; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

Claims 21-54 (canceled).

Claim 55 (previously presented): A compound of claim 2, wherein R^2 is substituted phenyl.

Claim 56 (previously presented): A compound of claim 7, wherein X is -O-.

Claim 57 (previously presented): A compound of claim 7, wherein X is -S-.

Claim 58 (previously presented): A compound of claim 7, wherein the compound is of formula Ii.

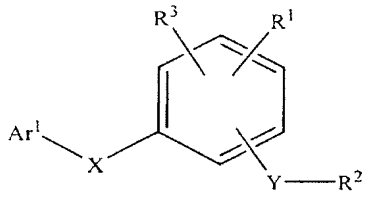
Claim 59 (previously presented): A compound of claim 15, wherein Ar^1 is unsubstituted naphthyl.

Claim 60 (previously presented): A compound of claim 19, wherein X is -S-.

Claim 61 (previously presented): A compound of claim 19, wherein X is -O-.

Claim 62 (previously presented): A compound of claim 19, wherein the compound is of formula Ii.

Claim 63 (currently amended): A composition comprising a pharmaceutically acceptable excipient and a compound having the formula:



wherein

Ar^1 is a substituted or unsubstituted phenyl or substituted or unsubstituted naphthyl;

X is a divalent linkage selected from the group consisting of ~~$(C_1$-$C_6)$alkylene, $(C_1$-$C_6)$alkylenoxy, $(C_1$-$C_6)$alkylenamino, $(C_1$-$C_6)$alkylene-$S(O)_k$-~~, -O-, -C(O)-, -~~$N(R^H)$-, -$N(R^H)C(O)$-~~, $-S(O)_k-$ and $-CH_2-$ ~~a single bond~~,

wherein

~~R^H is a member selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl, $(C_2$-$C_8)$heteroalkyl and aryl$(C_1$-$C_4)$alkyl; and~~ the subscript k is an integer of from 0 to 2;

Y is $N(R^{12})$-$S(O)_m$-,

wherein

R^{12} is ~~independently~~ selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl, $(C_2$-$C_8)$heteroalkyl and aryl$(C_1$-$C_4)$alkyl; and the subscripts m and n are independently integers of from 0 to 2;

R^1 is a member selected from the group consisting of hydrogen, $(C_2$-$C_8)$heteroalkyl, aryl, aryl$(C_1$-$C_4)$alkyl, halogen, cyano, nitro, $(C_1$-$C_8)$alkyl, $(C_1$-$C_8)$alkoxy, -$C(O)R^{14}$, -CO_2R^{14}, -$C(O)NR^{15}R^{16}$, -$S(O)_p$-R^{14}, -$S(O)_q$-$NR^{15}R^{16}$, -O-C(O)-OR^{17}, -O-C(O)-R^{17}, -O-C(O)-$NR^{15}R^{16}$, -$N(R^{14})$-C(O)-$NR^{15}R^{16}$, -$N(R^{14})$-C(O)-R^{17} and $-N(R^{14})$-C(O)-OR^{17};

wherein

R^{14} is a member selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl, $(C_2$-$C_8)$heteroalkyl, aryl and aryl$(C_1$-$C_4)$alkyl;

R^{15} and R^{16} are members independently selected from the group consisting of hydrogen, $(C_1$-$C_8)$alkyl, $(C_2$-$C_8)$heteroalkyl, aryl, and aryl$(C_1$-$C_4)$alkyl, or taken together with the nitrogen to which each is attached form a 5-, 6- or 7-membered ring;

R^{17} is a member selected from the group consisting of $(C_1\text{-}C_8)$alkyl, $(C_2\text{-}C_8)$heteroalkyl, aryl and aryl$(C_1\text{-}C_4)$alkyl;

the subscript p is an integer of from 0 to 3; and

the subscript q is an integer of from 1 to 2; and

R^2 is a substituted or unsubstituted aryl; and

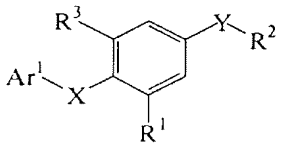
R^3 is a member selected from the group consisting of halogen, cyano, nitro and $(C_1\text{-}C_8)$alkoxy;

or a pharmaceutically acceptable salt of the compound.

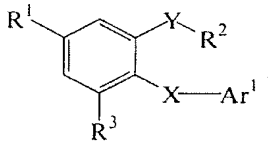
Claim 64 (previously presented): A composition of claim 63, wherein R^2 is a substituted or unsubstituted aryl selected from the group consisting of phenyl, pyridyl, naphthyl and pyridazinyl.

Claim 65 (previously presented): A composition of claim 64, wherein Ar^1 is a substituted or unsubstituted phenyl group.

Claim 66 (currently amended): A composition of claim 65, wherein the compound is represented by a formula selected from the group consisting of



and

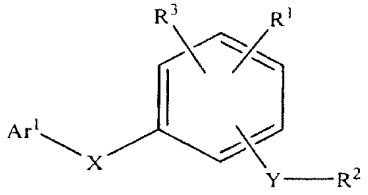


(Ii) (Ij)

and wherein X is ~~–O–, –NH–~~ or –S–; Y is -NH-SO_2-; R^1 is a member selected from the group consisting of halogen, $(C_1\text{-}C_8)$alkyl, $(C_2\text{-}C_8)$heteroalkyl, $(C_1\text{-}C_8)$alkoxy, $-C(O)R^{14}$, $-CO_2R^{14}$, $-C(O)NR^{15}R^{16}$, $-S(O)_p\text{-}R^{14}$ and $-S(O)_q\text{-}NR^{15}R^{16}$; R^2 is a phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, $-OCF_3$, -OH, $-O(C_1\text{-}C_8)$alkyl, $-C(O)\text{-}(C_1\text{-}C_8)$alkyl, -CN, $-CF_3$, $(C_1\text{-}C_8)$alkyl and $-NH_2$; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

Claim 67 (previously presented): A composition of claim 66, wherein Ar^1 is a phenyl group having from 1 to 3 substituents selected from the group consisting of halogen, $-OCF_3$, -OH, $-O(C_1\text{-}C_6)$alkyl, $-CF_3$, $(C_1\text{-}C_8)$alkyl and $-NO_2$; R^1 is a member selected from the group consisting of halogen, $(C_1\text{-}C_8)$alkyl, $(C_2\text{-}C_8)$heteroalkyl and $(C_1\text{-}C_8)$alkoxy; R^2 is a

Claim 73 (withdrawn; currently amended): A method for modulating conditions associated with metabolic or inflammatory disorders in a host, said method comprising administering to said host an efficacious amount of a compound having the formula:



wherein

Ar^1 is a substituted or unsubstituted phenyl or substituted or unsubstituted naphthyl;

X is a divalent linkage selected from the group consisting of ~~(C_1-C_6)alkylene, (C_1-C_6)alkylenoxy, (C_1-C_6)alkylenamino, (C_1-C_6)alkylene-$S(O)_k$-~~, -O-, -C(O)-, -~~$N(R^{11})$-, $N(R^{11})C(O)$-~~, $-S(O)_k-$ and $-CH_2-$ ~~a single bond~~,

wherein

~~R^{11} is a member selected from the group consisting of hydrogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl and aryl(C_1-C_4)alkyl; and~~ the subscript k is an integer of from 0 to 2;

Y is $N(R^{12})-S(O)_m-$,

wherein

R^{12} is ~~independently~~ selected from the group consisting of hydrogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl and aryl(C_1-C_4)alkyl; and the subscripts m and n are independently integers of from 0 to 2;

R^1 is a member selected from the group consisting of hydrogen, (C_2-C_8)heteroalkyl, aryl, aryl(C_1-C_4)alkyl, halogen, cyano, nitro, (C_1-C_8)alkyl, (C_1-C_8)alkoxy, $-C(O)R^{14}$, $-CO_2R^{14}$, $-C(O)NR^{15}R^{16}$, $-S(O)_p-R^{14}$, $-S(O)_q-NR^{15}R^{16}$, -O-C(O)-OR^{17}, -O-C(O)-R^{17}, -O-C(O)-$NR^{15}R^{16}$, $-N(R^{14})-C(O)-NR^{15}R^{16}$, $-N(R^{14})-C(O)-R^{17}$ and $-N(R^{14})-C(O)-OR^{17}$.

wherein

R^{14} is a member selected from the group consisting of hydrogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl, aryl and aryl(C_1-C_4)alkyl;

R^{15} and R^{16} are members independently selected from the group consisting of hydrogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl, aryl, and aryl(C_1-C_4)alkyl, or taken together with the nitrogen to which each is attached form a 5-, 6- or 7-membered ring;

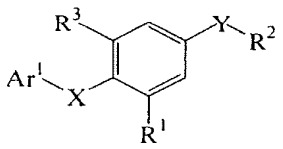
R^{17} is a member selected from the group consisting of (C_1-C_8)alkyl, $(C_2-$

phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_8)alkyl, -C(O)-(C_1-C_8)alkyl, -CN, -CF_3, (C_1-C_8)alkyl and -NH_2; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

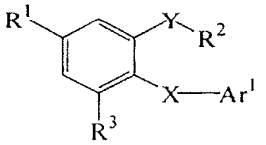
Claim 68 (previously presented): A composition of claim 67, wherein the compound is of formula Ii.

Claim 69 (previously presented): A composition of claim 63, wherein Ar^1 is substituted or unsubstituted naphthyl group.

Claim 70 (currently amended): A composition of claim 69, wherein the compound is represented by a formula selected from the group consisting of



and



(Ii) (Ij)

and wherein X is –O-~~, –NH-~~ or –S-; Y is -NH-SO_2-; R^1 is a member selected from the group consisting of halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl, (C_1-C_8)alkoxy, -C(O)R^{14}, -CO_2R^{14}, -C(O)$NR^{15}R^{16}$, -$S(O)_p$-R^{14} and -$S(O)_q$-$NR^{15}R^{16}$; R^2 is a phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_8)alkyl, -C(O)-(C_1-C_8)alkyl, -CN, -CF_3, (C_1-C_8)alkyl and -NH_2; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

Claim 71 (previously presented): A composition of claim 70, wherein Ar^1 is a naphthyl group having from 1 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_6)alkyl, -CF_3, (C_1-C_8)alkyl and -NO_2; R^1 is a member selected from the group consisting of halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl and (C_1-C_8)alkoxy; R^2 is a phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_8)alkyl, -C(O)-(C_1-C_8)alkyl, -CN, -CF_3, (C_1-C_8)alkyl and -NH_2; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

Claim 72 (previously presented): A composition of claim 71, wherein the compound is of formula Ii.

C_8)heteroalkyl, aryl and aryl(C_1-C_4)alkyl;

the subscript p is an integer of from 0 to 3; and

the subscript q is an integer of from 1 to 2; and

R^2 is a substituted or unsubstituted aryl; and

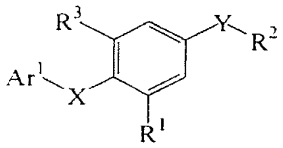
R^3 is a member selected from the group consisting of halogen, cyano, nitro and (C_1-C_8)alkoxy;

or a pharmaceutically acceptable salt of the compound.

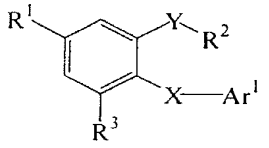
Claim 74 (withdrawn): The method of claim 73, wherein R^2 is a substituted or unsubstituted aryl selected from the group consisting of phenyl, pyridyl, naphthyl and pyridazinyl.

Claim 75 (withdrawn): The method of claim 73, wherein Ar^1 is a substituted or unsubstituted phenyl group.

Claim 76 (withdrawn; currently amended): The method of claim 75, wherein the compound is represented by a formula selected from the group consisting of



and



(Ii) (Ij)

and wherein X is ~~–O–, –NH–~~ or –S–; Y is -NH-SO_2-; R^1 is a member selected from the group consisting of halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl, (C_1-C_8)alkoxy, -C(O)R^{14}, -CO_2R^{14}, -C(O)$NR^{15}R^{16}$, -$S(O)_p$-R^{14} and -$S(O)_q$-$NR^{15}R^{16}$; R^2 is a phenyl group having from 0 to 3 substitutents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_8)alkyl, -C(O)-(C_1-C_8)alkyl, -CN, -CF_3, (C_1-C_8)alkyl and -NH_2; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

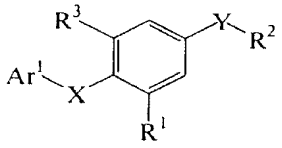
Claim 77 (withdrawn): The method of claim 76, wherein Ar^1 is a phenyl group having from 1 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_6)alkyl, -CF_3, (C_1-C_8)alkyl and -NO_2; R^1 is a member selected from the group consisting of halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl and (C_1-C_8)alkoxy; R^2 is a phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, -OCF_3, -

OH, -O(C_1-C_8)alkyl, -C(O)-(C_1-C_8)alkyl, -CN, -CF_3, (C_1-C_8)alkyl and -NH_2; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

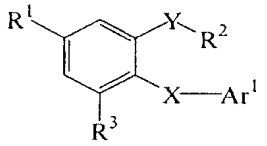
Claim 78 (withdrawn): The method of claim 77, wherein the compound is of formula Ii.

Claim 79 (withdrawn): The method of claim 73, wherein Ar^1 is a substituted or unsubstituted naphthyl group.

Claim 80 (withdrawn; currently amended): The method of claim 79, wherein the compound represented by a formula selected from the group consisting of



and



(Ii) (Ij)

and wherein X is –O-, ~~–NH–~~ or –S-; Y is -NH-SO_2-; R^1 is a member selected from the group consisting of halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl, (C_1-C_8)alkoxy, -C(O)R^{14}, -CO_2R^{14}, -C(O)$NR^{15}R^{16}$, -S(O)$_p$-R^{14} and -S(O)$_q$-$NR^{15}R^{16}$; R^2 is a phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_8)alkyl, -C(O)-(C_1-C_8)alkyl, -CN, -CF_3, (C_1-C_8)alkyl and -NH_2; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

Claim 81 (withdrawn): The method of claim 80, wherein Ar^1 is a naphthyl group having from 1 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_6)alkyl, -CF_3, (C_1-C_8)alkyl and -NO_2; R^1 is a member selected from the group consisting of halogen, (C_1-C_8)alkyl, (C_2-C_8)heteroalkyl and (C_1-C_8)alkoxy; R^2 is a phenyl group having from 0 to 3 substituents selected from the group consisting of halogen, -OCF_3, -OH, -O(C_1-C_8)alkyl, -C(O)-(C_1-C_8)alkyl, -CN, -CF_3, (C_1-C_8)alkyl and -NH_2; and R^3 is selected from the group consisting of halogen, methoxy and trifluoromethoxy.

Claim 82 (withdrawn): The method of claim 81, wherein the compound is of formula Ii.

Claim 83 (withdrawn): The method of claim 73, wherein said host is a mammal selected from the group consisting of humans, dogs, monkeys, mice, rats, horses and cats.

Claim 84 (withdrawn): The method of claim 73, wherein said administering is oral.

Claim 85 (withdrawn): The method of claim 73, wherein said disorders are selected from the group consisting of NIDDM, obesity, hypercholesterolemia and inflammatory conditions.

Claim 86 (withdrawn): The method of claim 85, wherein said metabolic disorders are mediated by PPARγ.

REMARKS

This paper responds to the Office Action mailed December 18, 2006. Claims 1-8, 15-20, and 55-86 were pending and claims 1-8, 15-20, and 55-72 were under consideration in connection with the present application. In this paper, claims 1, 6, 7, 18, 19, 63, 66, 70, 73, 76, and 80 are amended, and no claims are cancelled or newly presented for consideration. Accordingly, claims 1-8, 15-20, and 55-86 remain pending and claims 1-8, 15-20, and 55-72 remain under consideration.

I. The Amendments to the Claims

This paper presents an amendment to claims 1, 6, 7, 18, 19, 63, 66, 70, 73, 76, and 80. The amendments to claims 1, 6, 7, 17, 18, 19, 63, 66, 70, 73, 76, and 80 are fully supported by the application as filed. Accordingly, the amendments to the claims present no new matter.

In particular, the amendments to claims 1, 6, 7, 18, 19, 63, 66, 70, 73, 76, and 80 are supported by the originally filed versions of the amended claims, as the sole change presented by each of the amendments to the claims is to delete members of a Markush group, with one exception. As the application as filed describes the entire Markush group, it necessarily describes the portion of the Markush group recited by the amended claims. *See See In re Johnson* 558 F.2d 1008, 1019, 194 U.S.P.Q. 187, 196 (C.C.P.A., 1977). In addition, Applicants have replaced the $(C_1\text{-}C_6)$alkylene group recited by claims 1, 63, and 73 with a $-CH_2-$ moiety. This amendment is supported by, for example, claim 6 as filed and the specification at paragraphs 16 and 38 (in the version of the application published as U.S. Patent Application Publication No. 20040248882). Accordingly, the amendments to the claims are fully supported by the application as filed and introduce no new matter.

In addition, entry of the amendments to the claims after final rejection is believed proper because the amendments narrow the issues remaining and therefore present the claims in better form for consideration on appeal. Entry of the amendments to the claims is therefore respectfully requested pursuant to 37 C.F.R. § 1.116..

II. Restriction

Claims 73-86 stand withdrawn as directed to a non-elected invention and relate to methods for modulating conditions or disorders associated with metabolic or inflammatory disorders. Applicants respectfully remind the PTO that claims 73-86 are method claims that recite all the limitations of the compounds encompassed by, for example, claim 1. As such, Applicants respectfully submit that withdrawn method claims 73-86 should be rejoined after

the compound claims presently under examination are deemed allowable by the PTO. *See* M.P.E.P. § 821.04(b).

III. The Rejection of Claims 1-8, 15-20, and 55-72 as Failing to Comply with the Enablement Requirement of 35 U.S.C. § 112, First Paragraph Should be Withdrawn

Claims 1-8, 15-20, and 55-72 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Without acquiescing to the propriety of the rejection, and solely to expedite allowance of the claims, Applicants have amended the claims to recite subject matter that the Patent Office acknowledges is enabled. Accordingly, Applicants believe the rejection is moot. Applicants therefore respectfully request withdrawal of the rejection of claims 1-8, 15-20, and 55-72 as failing to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

IV. The Rejection of Claims 1-8, 15-20, and 55-72 under the Judicially-Created Doctrine of Obviousness-Type Double Patenting Should be Withdrawn

Claims 1-8, 15-20, and 55-72 stand rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly obvious variants of claims 1-33 of U.S. Patent No. 6,620,827 ("the '827 patent").

In response, Applicants respectfully submit that no claim of the '827 patent provides motivation to select the specific subgenus of compounds recited by 1-8, 15-20, and 55-72.[1] As such, the ordinarily-skilled artisan would not regard the subject matter of claims 1-8, 15-20, and 55-72 as obvious variants of any claim of the '827 patent.

A. The Legal Standard

Under the judicially-created doctrine of obviousness-type double patenting, a claim must be patentably distinct from a *claim* of an already issued patent or pending application. *See General Food Corp. v. Studiengesellshaft Kohle mbH*, 23 U.S.P.Q.2d 1839 (Fed. Cir. 1992; emphasis added). If the claim at issue defines more than an obvious variation of the patented or pending claim, it is patentably distinct and rejection of the claim under the doctrine of obviousness-type double patenting is improper. *Id.*

To establish a proper obviousness-type double patenting rejection, the Examiner must show that the claim at issue is a "mere variation" of the patented or pending claim that

[1] Applicants note that claims 1-8, 15-20, and 55-62 relate to a particular genus of compounds, while claims 63-72 relate to compositions comprising such compounds. Thus, the compositions of claims 63-72 recite the genus of compounds recited by claims 1-8, 15-20, and 55-62, and thus Applicants address claims 1-8, 15-20, and 55-72 together.

"would have been obvious to those of ordinary skill in the relevant art." *See In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986). In the analysis, the "patent disclosure may not be used as prior art;" instead, the Examiner must focus on the "subject matter that *has been protected*, not...something one may find to be disclosed by reading them" or the specification. *See General Food Corp.*, 23 U.S.P.Q.2d at 1846, quoting *In re Vogel*, 164 U.S.P.Q. 619, 622 (C.C.P.A. 1970) and *In re Boylan*, 157 U.S.P.Q. 370, 371 (C.C.P.A. 1968).

Moreover, a proper obviousness-type double patenting analysis parallels the obviousness analysis performed under 35 U.S.C. § 103(a). *See In re Braat*, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991) and M.P.E.P. § 804. Thus, arguments showing non-obviousness under 35 U.S.C. 103(a) may be made to show that a claim is not an obvious variant of a patented or pending claim. For example, Applicants may show that the claims at issue are not obvious variants of the patented claims by showing that such claims are not *prima facie* obvious variants of the patented claims. One way Applicants may show such non-obviousness is to show that the patented claims define a genus that does not suggest the species or subgenus recited by the claims at issue. *See In re Baird*, 29 U.S.P.Q.2d 1550 (Fed. Cir. 1994).

B. No Claim of the '827 Patent Suggests Selection of the Subgenus Recited by Claims 1-8, 15-20, and 55-72

The PTO argues that "the markush disclosed in the ['827] patent's opening pages contains the phenyl ring being optionally substituted and many examples (such as examples 48 and 49) contain a substituted phenyl ring." [Office Action, p. 7]. Applicants do not disagree with this description, but maintain that the specification of the '827 patent cannot be used to construct a proper obviousness-type double patenting rejection. Rather, as discussed above, an obviousness-type double patenting rejection is only concerned with *what is claimed* by the prior patent. None of the claims of the '827 patent recite a substituent for the central phenyl ring. As such, the claims of the '827 patent cannot possibly suggest selection of the particular substituents recited by the instant claims.

Further, neither the claims nor the specification of the '827 patent teaches or suggests the particular substituents defined by R^3 as recited by, for example, claims 1, 63 and 73 of the instant application. In the present claims, R^3 can be halogen, cyano, nitro or $(C_1$-$C_8)$alkoxy. No generic or specific compound disclosed by the '827 patent in either the claims or the specification comprises a halogen, cyano, nitro, and $(C_1$-$C_8)$alkoxy attached to an appropriate aromatic ring as recited by claim 1. Thus, for this additional reason, Applicants respectfully

submit that the obviousness-type double patenting rejection is improper and earnestly request its withdrawl.

CONCLUSION

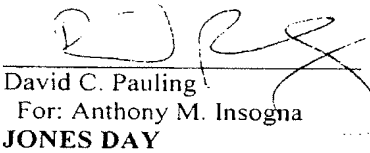
In light of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 739-3949, if a telephone call could help resolve any items remaining prior to allowance.

Applicants believe that no fee is due in connection with this response beyond the fees associated with the Petition for Extension of Time. Should an additional fee be required, the Commissioner is hereby authorized to charge any such required fee(s) to Jones Day Deposit Account No. 50-3013 (Referencing No. 893053-999123). A copy of this sheet is enclosed for such purpose.

By his signature below, Applicant hereby represents under Rule 34(b) of the Rules of Practice that this response is authorized by Amgen Inc.

Respectfully submitted,

Date: June 15, 2007



David C. Pauling (Reg. No. 56,056
For: Anthony M. Insogna (Reg. No. 35,203)

JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939

Express Mail No. EV 922 265 446 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	McGee et al.	Confirmation No.:	7972
Serial No.:	10/815,325	Art Unit:	1625
Filed:	March 25, 2004	Examiner:	Seaman, D. Margaret M.
For:	Compounds for the Modulation of PPARγ Activity	Attorney Docket No.:	T99-008-3/US (11134-123-999)

NOTICE OF APPEAL FROM THE PRIMARY EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision dated December 18. 2006 of the Primary Examiner finally rejecting claims 1-8, 15-20 and 55-72 of the above-identified application.

The item(s) checked below are appropriate:

1. ☒ An extension of time for responding to the final rejection for 3 month(s):
   - ☐ was filed on .
   - ☒ is submitted herewith.
2. ☒ A timely response to the final rejection is filed concurrently.
3. ☒ A fee in the amount of **$500.00** is:
   - ☒ Required.
   - ☐ Not required (Fee paid in prior appeal).
4. ☐ Applicant has qualified for the 50% reduction in fee for an independent inventor, non-profit organization or small business concern and a fee in the amount of **$250.00** is:
   - ☐ Required.
   - ☐ Not required (Fee paid in prior appeal).
5. ☒ Please charge the required fee, if any, to Jones Day Deposit Account No. 50-3013 (Referencing No. 893053-999123). A copy of this sheet is enclosed.

Respectfully submitted,

Date: June 15, 2007

56,056

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Filed:	March 25, 2004	Examiner:	Seaman, D. Margaret M.
For:	Compounds for the Modulation of PPARγ Activity	Attorney Docket No:	T99-008-3/US

PETITION FOR EXTENSION OF TIME UNDER 37 CFR § 1.136(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

It is respectfully requested that the time for response to Final Office Action, dated December 18, 2006, be extended for a period of 3 months from March 18, 2007 to and including June 18, 2007.

The fee for this extension is estimated to be $1020.00. Please charge the required fee to Jones Day Deposit Account No. 50-3013 (Referencing No. 893053-999123). A copy of this sheet is enclosed.

Respectfully submitted,

Date: June 15, 2007

(Reg. No. 56,056)

David C. Pauling
For: Anthony M. Insogna (Reg. No. 35,203)
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222 East 41st Street
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(212) 326-3939

LAI-2878132v1

H00042441

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	McGee et al.	Confirmation No.:	7972
Serial No.:	10/810,325	Art Unit:	1625
Filed:	March 25, 2004	Examiner:	Seaman, D. Margaret
For:	Compounds for the Modulation of PPARγ Activity	Attorney Docket No:	T99-008-3/US

PETITION FOR EXTENSION OF TIME UNDER 37 CFR § 1.136(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

It is respectfully requested that the time for response to the Office Action dated April 13, 2006 be extended for a period of three (3) month(s) from July 13, 2006 to and including October 13, 2006.

The fee for this extension is estimated to be $1020.00. Please charge the required fee to Amgen Deposit Account No. 50-0487, referencing order number T99-008-3/US. A copy of this sheet is enclosed.

Respectfully submitted,

Date: October 12, 2006

40,179
Christopher J. Smith (Reg. No.)

Customer Number: 30174

AMGEN INC
1120 Veterans Blvd.
South San Francisco, CA 94080

EXHIBIT C

Express Mail No. EV 922 265 446 US **Date Mailed: June 15, 2007**

Serial No. 10/819,325
Filing Date: March 25, 2004
Inventor: McGEE et al.
For COMPOUNDS FOR THE MODULATION OF PPARγ ACTIVITY

- ☐ Affidavit/Declaration
- ☐ Amendment ☐ Response
- ☐ Application pages **DIV**
- ☐ Claims Drawing Sheets
- ☐ Assignment ☐ Cover Sheet (from prior appl.)
- ☐ Declaration & Power of Attorney (from prior appl.)
  - ☐ Executed ☐ Unexecuted ☐ Copy
- ☐ Declaration of Inventors
  - ☐ Executed ☐ Unexecuted ☐ Copy
- ☐ Design Application
- ☐ Disclaimer ☐ Disclaimer Fee
- ☐ Disclosure Statement ☐ Form PTO-1449
  - ☐ w/refs.
- ☐ Drawings, Formal
  - Sheets Figures

File no.: 11134-123-999 (CAM 893053-999123)

- ☒ **Response to Final Office Action (last pg +1)**
- ☐ Copy of Notice to File Missing Parts
- ☒ **Petition for Extension of Time (3 mos.) (+1)**
- ☒ **Notice of Appeal (+1)**
- ☐ Other:
- ☐ Petition Under 37 C.F.R.
- ☐ Power of Attorney
  - ☐ By Assignee ☐ Associate ☐ w/Revocation
- ☐ Request for Correction of Filing Receipt
- ☐ Sequence Listing w/ Paper Copy & Transmittal of Sequence Listing
- ☐ Small Entity Statement
- ☐ w/o refs. ☐ Status Letter
- ☐ Utility Patent Application Transmittal
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